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Paper No. 17

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AUG 28 2002

OFFICE OF PETITIONS

In re Application of :
Al Bahaini :
Application No. 09/582,634 : ON PETITION
Filed: September 13, 2000 :
For: SHIRWO SYSTEM (A NEW INTERNAL :
COMBUSTION POWER SYSTEM) :

This is a decision on the petition under 37 C.F.R. § 1.137(a),
filed June 19, 2002, to revive the above-identified application.

The petition under 37 C.F.R. § 1.137(a) is **DISMISSED**.

The application became abandoned September 30, 2001 for failure to
timely submit a proper reply to the non-final Office action mailed
June 29, 2001. The non-final Office action set a three (3) month
shortened statutory period of time for reply. No extensions of
time in accordance with 37 C.F.R. § 1.136(a) were timely
requested. Notice of Abandonment was mailed May 14, 2002.

A grantable petition under 37 C.F.R. § 1.137(a) must be
accompanied by: (1) the required reply, unless previously filed;
(2) the petition fee as set forth in 37 C.F.R. § 1.17(l); (3) a
showing to the satisfaction of the Commissioner that the entire
delay in filing the required reply from the due date for the reply
until the filing of a grantable petition pursuant to 37 C.F.R. §
1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee
as set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37
C.F.R. § 1.137(c).

The present petition lacks requirement (3) above. Petitioner has
failed to present a showing to the satisfaction of the
Commissioner that the entire delay in filing the required reply
from the due date for the reply until the filing of a grantable
petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in
responding to the relevant outstanding Office requirement is shown
to the satisfaction of the Commissioner to have been
"unavoidable." See, 37 C.F.R. § 1.137(a)(3). Decisions on reviving
abandoned applications have adopted the reasonably prudent person

standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Ouigg, 673 F. Supp. 314, 5 U.S.P.Q.2d 1130 (N.D. Ind. 1987).

Petitioner alleges a response to the non-final Office action was mailed to the Office but that the response was not timely received. A review of the official application file does not indicate receipt of the alleged response. Petitioner, however, alleges the response "would have been timely and normally received in the USPTO between October 13, 2001 and January 2, 2002, but for the mail delay."

Petitioner's arguments have been considered and found unconvincing. While the Office experienced mail delays for many papers that were mailed by USPS First Class Mail and USPS Express Mail between October 13, 2001 and December 1, 2001, petitioner did not submit a response to the non-final Office action via USPS between October 13, 2001 and December 1, 2001. Petitioner is reminded that the Office does not recognize any mail courier service beyond USPS First Class Mail and USPS Express Mail.

Under the provisions of 37 CFR 1.8(a), correspondence is considered timely filed if: (1) the correspondence is mailed or transmitted prior to expiration of the set period for response by being properly addressed to the Patent and Trademark Office as set out in 37 C.F.R. § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail or transmitted to the Patent and Trademark Office in accordance with 37 C.F.R. § 1.6(d) and (2) that the correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission.

Further, under 37 CFR 1.8(b), in the event that correspondence is considered timely filed by being mailed or transmitted in accordance with 37 CFR 1.8(a), but not received in the Patent and Trademark Office, and the application is held to be abandoned or

the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence: (1) informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence; (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and (3) includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. The Office may require additional evidence to determine if the correspondence was timely filed. See, MPEP 711.03(c).

Under the provisions of 37 CFR 1.10(a), any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS.

Further, under 37 CFR 1.10(e), any person mailing correspondence addressed as set out in 37 CFR 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that: (1) the petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence; (2) the number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; (3) the petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to 37 CFR 1.10(d)(3) that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and (4) the petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing

label, returned postcard receipt, and official notation entered by the USPS. The Office may require additional evidence to determine if the correspondence as deposited as "Express Mail" with the USPS on the date in question.

The Office also has a well established and well publicized practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. A postcard receipt will not serve as *prima facie* evidence of receipt of any item not adequately itemized on the postcard. In addition, the mere incorporation by reference in the postcard receipt of the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items. See, MPEP 503.

Petitioner has provided no evidence that the response to the non-final Office action was filed in accordance with the provisions discussed above, i.e., 37 CFR 1.8 (certificate of mailing) or 37 CFR 1.10 (USPS Express Mail). Nor has petitioner provided a copy of a return postcard acknowledging Office receipt of the declaration. Accordingly, it can only be concluded that the declaration was not timely filed.

As a "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay within the meaning of 37 CFR 1.137(a). See, Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990).

Any renewed petition must be accompanied by evidence to establish that the response to the non-final Office action was timely mailed to the Office by means of USPS First Class mail or USPS Express Mail, or petitioner is required to supply a copy of a return postcard date-stamped by the Office acknowledging receipt of the response to the non-final Office action.

ALTERNATE VENUE

Petitioner is **strongly** urged to file a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the

delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee, statement of unintentional delay, reply, and, if applicable, a terminal disclaimer (and fee).

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Enclosed for petitioner's reference is a petition for revival of unintentionally abandoned application form.

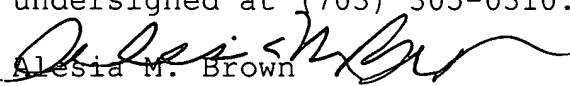
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By facsimile: (703) 308-6916

By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0310.


Alessia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosures: USPTO Privacy Statement
 Petition for Revival Form